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| 10/585,967 | 07/12/2006 | Jonny Boyd Reckless | 2147.020US1 | 6181 |

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| EXAMINER |
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SQUIRES, BRETT S

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| ART UNIT | PAPER NUMBER |
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2431

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07/01/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/585,967 | Applicant(s) RECKLESS ET AL. | |
| | Examiner BRETT SQUIRES | Art Unit 2431 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 24-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 8-11, 16, 24-28 and 30 is/are rejected.
- 7) ☒ Claim(s) 3, 6, 7 and 12-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Priority

1. The applicant's claim for the benefit of foreign priority based on an application filed in Great Britain on February 4, 2005 having the serial number GB 0502367.6 is denied. The examiner respectfully points out that the foreign priority benefits under 35 U.S.C. 119(a)-(d), are for an application for patent filed in the United States being entitled to the benefit of the filing date of **a prior application** filed in a foreign country. An international application for the purpose of 35 U.S.C. 365 (a)-(b) and 35 U.S.C. 119 (a)-(d) is considered to be a national application regularly filed in that country on the international filing data irrespective of whether the application was physically filed in that country. The present application is the United States nation stage of the PCT GB2005/000370 filed on February 4, 2005. Accordingly, the application filed in Great Britain on February 4, 2005 having the serial number GB 0502367.6 is not a prior application filed in a foreign country.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 18 of copending Application No. 11/715,144 in view of G@M3FR3@K, "What is Raw," posted May 1, 2001, pages 1-3.

Claim 1 of the present application corresponds to claim 18 of copending application no.11/715,144.

Claim 1 of the present application recites a method of copying a copy protected optical disc comprising "accessing the content on the copy protected optical disc by

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navigating to the content utilising the navigation paths provided for normal playback of the disc,” “storing the accessed content in a corresponding data area,” and “including arbitrary data in any regions of the corresponding data area which correspond to regions containing subversive data.”

Claim 18 of the copending application recites a method of copying content from a recording medium carrying content data and navigational command data that determines the order in which a player of the recording medium will access the content data comprising "accessing the recording medium to read content data and navigation data from a recording medium," and "storing data for enabling recording of the content data for the navigational path."

Claim 18 of the copending application does not recite the step of “including arbitrary data in any regions of the corresponding data area with correspond to regions containing subversive data.”

G@M3FR3@K discloses a method for copying a copy protected optical disc that replaces subversive data with zeros.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the step of replacing subversive data with zeros in the method recited by the copending application no.11/715,144 in order have a defect free copy of the content on the recording medium.

Claim 24 of the present application corresponds to claim 1 of copending application no. 11/715,144.

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Claim 24 of the present application recites an apparatus for copying a copy protected optical disc comprising "an access module for accessing the content on the disc by utilising the navigation provided for normal playback of the disc, said access module comprising a mapping module for mapping the navigation paths to identify regions of the data area which are not accessed by said navigation paths, and an access device for accessing regions of the data area which have not been identified as said regions, in a linear manner," "a storage module for storing the accessed content in a corresponding data area," and "an incorporation module for incorporating arbitrary data into any regions of the corresponding data area which correspond to regions containing subversive data."

Claim 1 of the copending application recites a copying apparatus for copying content from a recording medium comprising "a reader operable to access locations of the recording medium to read content data and navigation data from a recording medium," "a navigator operable to execute a navigation command in accordance with navigation data read by the reader," "a controller operable to control the location of the recording medium accessed by the reader in accordance with the execution of a navigation command by the navigator to cause the reader to follow a navigation path through the content data defined by the navigation data and to cause the presentation data storer to store data for enabling recording of the content data for the navigational path," and "a presentation data storer operable to store content data for recordal onto a recording medium." The examiner respectfully points out that there are only two options for content on an optical disc. The content is either accessible through navigation paths

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or the content is not accessible through navigations paths. Accordingly, mapping the content on the optical disc using either option will provide a mapping of all of the content on the disc because the content that does not fall within one classification will by default fall within the other classification. Consequently, mapping the content on the optical disc that is accessible through navigation paths will also provide a mapping for the content that is not accessible through navigation paths.

Claim 1 of the copending application does not recite the element "an incorporation module for incorporating arbitrary data into any regions of the corresponding data area which correspond to regions containing subversive data."

G@M3FR3@K discloses a method for copying a copy protected optical disc that replaces subversive data with zeros.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an element that performs replacing subversive data with zeros in the method recited by the copending application no.11/715,144 in order have a defect free copy of the content on the recording medium.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5, 8-11, 16, 24-28, and 30 are rejected under 35 U.S.C. 103(a) as being obvious over Guglielmino (US 4,584,641).

Regarding Claims 1, 4 and 24:

Guglielmino discloses a method of copying a copy protected optical disc ("Target Disk" See col. 1 lines 66-68 and col. 2 lines 1-41), the copy protected optical disc carrying content ("User Software Program" See col. 1 lines 32-44) and control data ("Volume Table of Contents" See col. 2 lines 42-56) in a data area, the content being arranged in one or more content files (The examiner respectfully points out that it is inherent that a software program is arranged in one or more content files.) and the control data providing access to the content (The examiner respectfully points out that it is inherent that the volume table of contents provides access to the content.), wherein at least one region of the content which contains subversive data is provided within the data area ("The target disk may be prepared by placing a permanent input/output error on either a blank disk or a disk with an existing software program." See col. 2 lines 1-41) and navigation is provided for normal playback of the copy protected optical disc ("The volume table of contents (VTOC) of said target disk may be programmed to indicate that the location of the permanent I/O error(s) is no longer available for program storage or data storage." See col. 2 lines 42-56), the navigation having navigation paths defined by the control data which can be used for access to the content on the copy protected optical disc (The examiner respectfully points out that it is inherent that the volume table of contents stores the track and sectors locations of the user software program.), and wherein during normal playback of the content on the copy protected optical disc

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utilizing the navigation paths access to the at least one region of subversive data is prevented ("The permanent input/output error may include a plurality of permanent input/output errors identifiable by track and sector locations." See col. 2 lines 42-56), the method performing: accessing the content on the copy protected optical disc by navigating to the content utilizing the navigation paths provided for normal playback of the copy protected optical disc (The examiner respectfully points out that it is inherent that the volume table of contents stores the track and sectors locations of the user software program.), storing the accessed content in a corresponding data area ("If the software program's ability to write information on the track and sector location identified as a permanent input/output error location 24, indicates that the software program is no longer on the target disk but instead on a copied or pirated disk," See col. 4 lines 12-25 The examiner respectfully points out that when making a copy of the target disk the user software program is stored in the corresponding tracks and sectors on the copied or pirated disk while blank data is stored in tracks and sectors corresponding to permanent input/out errors.), and including arbitrary data in any regions of the corresponding data area which correspond to regions containing subversive data (The examiner respectfully points out that the track and sector locations containing permanent input/output errors are replaced on the copied or pirated disk with blank data.).

Guglielmino further discloses placing an input/output error trap program on the target disk such that when the content of the target disk is copied to a copied or pirate disk the trap program will render the copied or pirate disk useless (See col. 3 lines 55-68 and col. 4 lines 1-25).

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The examiner respectively points out that the omission of the input/output error trap program by a software pirate is obvious, because the omission of an element and its function is obvious if the function of the element is not desired. See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989), *In re Larson* 340 F.2d 965, 144 USPQ 346 (CCPA 1965), and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Regarding Claims 2 and 25:

Guglielmino discloses the copied or pirate disk does not contain permanent input/output errors (See col. 4 lines 12-25). Therefore, the omission of the listing of tracks and sectors in the volume table of contents is obvious, because the omission of an element and its function is obvious if the function of the element is not desired. See *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989), *In re Larson* 340 F.2d 965, 144 USPQ 346 (CCPA 1965), and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

Regarding Claim 5 and 26:

Guglielmino discloses there are navigation paths which lead to the at least one region of subversive data ("The volume table of contents (VTOC) of said target disk may be programmed to indicate that the location of the permanent I/O error(s) is no longer available for program storage or data storage." See col. 2 lines 42-56), but such navigation paths are such that they do not provide access to the subversive data during normal playback of the content on the copy protected optical disc ("If the software program locates the permanent input/output error, 25, as indicated by Y, 27, the software program returns to the user software program, 28, and normal processing

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continues, 28." See col. 4 lines 6-9. The examiner further points out that the input/output error trap program authenticates the disk before execution the user software program, and the execution of the user software program is considered normal playback of the content on the target disk.)

Regarding Claims 8-9, 27-28, and 30:

Guglielmino discloses a conventional disk drive such as that of an Apple II computer is utilized for playback and copying of the copy protected optical disc (See col. 2 lines 17-18).

Regarding Claim 10:

Guglielmino discloses producing a copied or pirated disk that does not contain the permanent input/output errors (See col. 4 lines 12-19).

Regarding Claim 11:

Guglielmino discloses the at least one region of subversive data is formed as a gap between two adjacent content files ("The target disk may be prepared by placing a permanent input/output error on either a blank disk or a disk with an existing software program." and "The location of the track and sector on the target may be determined by a software program through the use of disk drive 50 as shown in Fig. 3A." See col. 2 lines 5-20).

Regarding Claim 16:

Guglielmino inherently discloses the arbitrary data included in the regions of the data area are sectors of zero because blank sectors on a disk are read by a computer a zeros.

Response to Amendment

6. The declaration under 37 CFR 1.132 filed March 30, 2009 is sufficient to overcome the rejection of claims 1-16, 24-28, and 30 under 35 U.S.C. 102(f). The examiner particularly points out that statements 11 and 12 by Jonny Boyd Reckless overcome the rejection made under 35 U.S.C. 102(f).

Allowable Subject Matter

7. Claims 3, 6-7, and 12-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRETT SQUIRES whose telephone number is (571) 272-8021. The examiner can normally be reached on 9:30am - 6:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BS/

/William R. Korzuch/
Supervisory Patent Examiner, Art Unit 2431